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EXAMINER

NGUYEN, TRI V

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD FRANCIS MCBREARTY,
SHAWN PATRICK MULLEN, and
JOHNNY MENG-HAN SHIEH

Appeal 2009-010441
Application 09/899,453
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Gerald Francis McBrearty, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 3-5, 7, 9-11, 13, 15-17, 19, and 20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.²

THE INVENTION

The invention relates “to computer managed communication networks, such as the World Wide Web (Web), and particularly to ease of use of interactive computer 10 controlled display interfaces to such networks for improving user shopping on the Web.” Specification 1:7-11.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. In a World Wide Web (Web) communication network with user access through a plurality of data processor controlled user interactive receiving display stations, a system for buying products offered from Web sites comprising:

means at a receiving display station for displaying a Web page accessed from a Web site;

means for selecting a product offered for sale from said Web page;

means for storing at said receiving station, a set of predetermined search queries respectively to each of a set

² We have considered the Appellants’ Appeal Brief (“App. Br.,” filed Jul. 28, 2008) and Reply Brief (“Reply Br.,” filed Dec. 16, 2008), and the Examiner’s Answer (“Answer,” mailed Oct. 16, 2008).

of Web database sites for data related to attributes of a selected product; and

means responsive to a selection of a product for automatically sending said search queries to said Web database sites wherein a purchase profile of the product is provided.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ng	US 6,405,175 B1	Jun. 11, 2002
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The following rejections are before us for review:

1. Claims 19 and 20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.
2. Claims 1, 3-5, 7, 9-11, 13, 15-17, 19, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ng.

ISSUES

Did the Examiner err in rejecting claims 19 and 20 as indefinite under 35 U.S.C. §112, second paragraph, and claims 1, 3-5, 7, 9-11, 13, 15-17, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Ng?

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

ANALYSIS

The rejection of claims 19 and 20 as indefinite under 35 U.S.C. §112, second paragraph.

The Appellants have not disputed the Examiner's assertion that the claims are indefinite for lack of antecedent basis. Accordingly, the rejection is sustained.

The rejection of claims 1, 3-5, 7, 9-11, 13, 15-17, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Ng.

The Appellants argued claims 1, 3-5, 7, 9-11, 13, 15-17, 19, and 20 as a group (App. Br. 9-13). We select claim 1 (*supra*) as the representative claim for this group, and the remaining claims 3-5, 7, 9-11, 13, 15-17, 19, and 20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that:

There is no suggestion in Ng's product information searches of storing a set of predetermined search queries respectively to each of a set of Web database sites for: data related to attributes of a selected product, or for automatically sending these predetermined search queries to Web database sites to obtain an attribute profile of the purchaser selected product.

App. Br. 10. See also Reply Br. 3.

We will sustain the rejection.

Claim 1 has been drafted in means-plus-function format.

According to 35 U.S.C. § 112, paragraph 6:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6, is a two step process.

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed.Cir.2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed.Cir.2002). . . . The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’ ” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed.Cir.1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

Therefore, we must first construe the limitations at issue. They call for (a) means for storing at said receiving station, a set of predetermined search queries respectively to each of a set of Web database sites for data related to attributes of a selected product; and (b) means responsive to a selection of a product for automatically sending said search queries to said Web database sites wherein a purchase profile of the product is provided. According to the Specification, these “may be made available as a plug-in program for any standard browser program” (4:30-31). The Specification also refers to the common operation of well-known browsers. See p. 10 of

the Specification. Therefore, the two “means” requires the corresponding structure or an equivalent of such a known browser.

The Appellants’ argument does not address whether Ng describes the corresponding structure or an equivalent, as construed above.

Instead, the Appellants argue over the type of information being stored and automatically sent; that is, “a set of predetermined search queries respectively to each of a set of Web database sites for data related to attributes of a selected product.” See element 85 in Fig. 5 and associated disclosure at p.12 of the Specification. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate (e.g., the browser). *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). In that regard, the Appellants have not come forward with evidence sufficient to show that the structure of the browser is functionally affected by storing “a set of predetermined search queries respectively to each of a set of Web database sites for data related to attributes of a selected product” as opposed to other information like the product information stored as disclosed in Ng. Absent such evidence, it is reasonable to conclude that the claim limitation of storing “a set of predetermined search queries respectively to each of a set of Web database sites for data related to attributes of a selected product” is descriptive and not functionally related to any structure of the claimed system and as such falls under the category of patentably inconsequential subject matter. *See Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative) (“Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to

nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (*i.e.*, the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

“Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.” *See also Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (informative).

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d at 1339. *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

For the foregoing reasons, we are not persuaded as to error in the rejection of claim 1. Because claims 3-5, 7, 9-11, 13, 15-17, 19, and 20 stand or fall with claim 1, their rejection is also sustained.

DECISION

The decision of the Examiner to reject claims 19 and 20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as

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the invention and claims 1, 3-5, 7, 9-11, 13, 15-17, 19, and 20 under 35
U.S.C. § 103(a) as unpatentable over Ng is affirmed.

AFFIRMED

MP

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